

### **REMARKS**

Claims 1-21 are pending in the application. By this amendment, claims 1, 8 and 15 have been amended. No new matter is added by these amendments. Applicant respectfully requests continued consideration of this application based on the foregoing amendments and the remarks urged here.

### **35 U.S.C. § 103 Rejections**

#### **Governing Criteria**

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in *KSR* enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. "Virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

Discussion of Rejections

Claims 1-2 and 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eggleston et al. (U.S. Patent No. 6,101,531) in view of Joseph (U.S. Patent No. 6,038,603) and further in view of Schwartz et al. (U.S. Patent No. 6,473,609). Applicant respectfully traverses this rejection.

Eggleston does not teach each and every element of the claims. With respect to the various elements of claim 1, the Examiner has cited the following either in whole or in part (hereinafter referred as the "Examiner Cite"):

In the illustrated case client 201 includes a data transfer manager or exchange unit 206, which in simple form could be an appropriately programmed electronic processor 207 (e.g., a general purpose CPU (central processing unit) and memory or data store 211. A timer 205 is also preferably employed in the data exchange control process, as will be explained further in connection with the flow chart of FIG. 3 below. A typical client 201 would also include some form(s) of user interface such as display 204, a data encoder/decoder 203 to accommodate the system communications protocol(s), and a transceiver (if using rf or infrared communications) and a modulator-demodulator (or modem) 202 to connect to a wireless or wireline communications network. Transceiver/modem 202 in this case would either include a built-in or attached user module for wireless LAN communications; the specific type will vary depending on the system, e.g., including PCMCIA (personal computer memory card interface association) wireless modems, and attached or built-in PSTN (public switched telephone network) modem, etc. Specific features of data exchange unit 206 preferably includes (as more fully described below) a prestige filter (PSF) manager 208, rate governor (RG) 209, user profile store 212, select and summary index store 213, and mail store 214 (a store being any available device (e.g., ROM (read-only memory), disks) or program (e.g., a database) for storage of the specified information).

The communication server 220 preferably includes a data transfer manager or controller 229 having a VSM 230, memory stores for storing active client profile

(user parameters) and inactive client profile information 226 and 227, a timer 224, and optionally some form of protocol translators or formatters 222. The VSM 230 serves to manage the virtual session with the client 201 and session with host systems 240, 255 and/or 260 based on the parameters loaded into the active user parameter store/profile memory 226 or object. Controller 229 preferably also includes a query manager (QM) 231 for controlling specific processes (e.g., sending messages to a post office to query for unprocessed messages and forwarding received messages etc.), and a prestage filter 232 and rate governor 234. Memory 225 also preferably includes a client select and summary index database or store 228, which will also be described more fully below in connection with FIGS. 7 and 8. The protocol translators 222 serve to format or code the messages as appropriate for transport between the VSM 230 and client 201; these include, e.g., appropriate protocol software that can be located at the communications server, or any other convenient processor per design of the given communication system. By messages is meant any appropriate data unit (whether a frame, datastream, packet, or other format), including objects, datagrams, etc., for containing information being communicated. Col. 5, line 23 – col. 6, line 7.

However, none of the above disclosure relates to the claimed invention. Eggleston is a system for enabling a user to specify criteria to filter data from a server (e.g., a mail server) over cost intensive networks (e.g., see Eggleston, claim 1). The purpose of Eggleston's invention is to filter and prevent certain types of data so that communications between a host and a wireless client are optimized. Eggleston's invention achieves this purpose by employing a Virtual Session Manager (VSM) to establish and maintain a sessionless communication path with one device while maintaining a session-oriented path with another device. See col. 2, line 56 – col. 4, line 8.

Furthermore, Eggleston's client does not possess an exchange manager as claimed. The client is only capable of communicating with the protocol for which it was originally coded. Moreover, even if the VSM were equivalent to the claimed exchange manager, a VSM does not exist on the client. This fact alone prevents any prima facie case of obviousness to be established.

The present invention as claimed enables developers to forgo coding applications with the requirements of each and every transport mechanism and protocol an electronic device may use. Moreover, the present invention as claimed enables developers to exchange data without the need for separately developing "conduit programs." As such, the exchange manager enables a developer to rely on an electronic device to send data using a proper protocol for the identified transport mechanism as claimed. As stated in the previous office action, resident applications on

the electronic device generate URL's that identify a transport mechanism and a communication protocol to use. Eggleston and the present invention as claimed solve two quite disparate problems further revealing the deficiency of using Eggleston to provide a prima facie case of obviousness.

With regard to element a) of claim 1, the Examiner states "forwarding information from an active application on said electronic device" is disclosed by "forwarding information from an active application (such as forwarding a URL request from a browser application) on the mobile end computer system 201 to a data transfer manager or exchange unit 206 on said mobile computer system." Again, the data exchange unit in Eggleston does not contain the claimed exchange manager's functionality. For example, Eggleston's exchange unit comprises

a prestage filter (PSF) manager 208, a rate governor (RG) 209, a user profile store 212, select and summary index store 213, and mail store 214 (a store being any available device (e.g., ROM (read-only memory), disks) or program (e.g., a database) for storage of the specified information. Col. 5, lines 44-48.

As no exchange manager exists on the client, it is impossible for the client to perform **any** of the claimed functionality. This lack of an exchange manager also reveals that Eggleston is incapable of disclosing elements b) and c) of claim 1.

Additionally, the Examiner states "based on an application's requirement, said step a) performed by an application resident on said electronic device, said exchange manager configured for converting said information to a file for communication" is disclosed by

since the data transfer manager or exchange unit 206 communicates/exchanges information with the communication server 220 by messages of any appropriate data unit (such as frame, datastream, packet, or other format), including objects, datagrams, etc., for containing information being communicated, said data transfer manager or exchange unit 206 must have formatted/converted said information to the appropriate data unit such as datastream file to communicate with the communication server 220. Office Action, p. 3.

Again, the exchange unit on Eggleston's client is not the claimed exchange manager. Eggleston discloses a data encoder/decoder, which encodes/decodes the data to be transmitted according to one protocol, that is, the protocol used by the client. No capability as claimed is disclosed because Eggleston does not contemplate an exchange manager. As such, Applicant respectfully submits the assumption made by the Examiner that "said data transfer manager or exchange unit 206 must have formatted/converted said information to the appropriate data unit such as

datastream file to communicate with the communication server 220" is incorrect. Moreover, the cited passage refers to the capability of the communications server and **not** the client.

With regard to element b) of claim 1, the Examiner states "in response to said information, said exchange manager referencing an exchange library from a plurality of exchange libraries, wherein said exchange library defines a communication protocol for said identified transport mechanism and wherein said exchange manager supports a plurality of communication protocols" is disclosed by "the data exchange unit 206 referencing/accessing data encoder/decoder 203 to accommodate, i.e., to support, the system communications protocols and a transceiver/modem 202 to connect to a wireless or wireline communications network."

However, no disclosure of exchange libraries exists within the Examiner's Cite or explanation. As stated above, the client has a data encoder/decoder that simply codes the data to be sent from the client. No mechanism is disclosed that allows an application to utilize an exchange manager as claimed in element b).

With regard to element c) of claim 1, the Examiner states "communicating said information to a system as a file identifiable by an application on a device external to said electronic device, identified by said destination, that is external to said electronic device using said communication protocol" is disclosed by

via the data encoder/decoder 203 and the transceiver 202, the data transfer manager or exchange unit 206 communicates/exchanges said information with the communication server 220, VMS 230, local email post office 240, remote client-server host 255, and/or administrator host server 260, etc., identified by the destination address that is external to the mobile end device 201, by messages of any appropriate data unit such as frame datastream, etc.). Office Action, p. 3-4.

Applicant respectfully submits that Eggleston's client does not communicate a file that is identifiable by an application on a device external to said electronic device as claimed.

Additionally, the Examiner states "said step c) performed by said identified transport mechanism, said application on said device external to said electronic device performing any necessary format conversion on said file" is disclosed by "for example, said browser application on the remote client-server host 255 is capable of performing any necessary format conversion on said stream file for displaying an HTML file as a web page on the display monitor, playing audio/video stream file to the speaker/monitor screen." Applicant is unclear where the "said

browser application on the remote client-server” is disclosed and how its capabilities have been ascertained. Moreover, “for displaying an HTML file as a web page on the display monitor” has little relevance to the present claims. The present claims do not claim displaying HTML files on web pages. Element c) is directed towards an application on a device external to the original electronic device that receives a file and performs any needed format conversions so that it may be stored on the device external to the original electronic device.

As such, Eggleston discloses none of the elements above. For this reason alone, Applicant respectfully submits that a prima facie case of obviousness cannot be advanced.

Joseph does not cure Eggleston’s deficiencies. The Examiner states that Joseph teaches resources that may be uniquely identified through the use of a uniform resource locator. Applicant agrees. However, this is not what is claimed. Joseph identifies a URL is used to identify an external resource that is then delivered back to the originating client. See e.g., Joseph, Fig. 10. As such, Joseph does not teach any element of the present claims.

Schwartz does not cure the Eggleston-Joseph combined deficiencies. Applicant respectfully submits that Schwartz has little or no applicability to the present claims. The Examiner states “Schwartz teaches a method and system for allowing mobile devices to interact effectively with the Internet.” This is not directed to any of the claim elements. Furthermore, the Examiner states that the “SDD format is unidentifiable to said device external to said handheld device” and thus discloses a portion of element c) of claim 1. However, Applicant submits that claim 1 is being misread. Claim 1 provides that once a device external to the electronic device receives a file, the device performs a conversion if the data type is unidentifiable to that device. Schwartz’s SDD is a format that must be recognizable to the device it is on else it could not be displayed. If it is not recognizable, Schwartz’s invention is inoperable. As such, Schwartz adds nothing to Eggleston-Joseph.

Eggleston, Joseph, and Schwartz, alone or in combination, do not teach or suggest each and every element of the claims. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claims 3-7 and 10-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eggleston, Joseph, and Schwartz in view of U.S. Patent No. 6,295,541 to Bodnar et al. ("Bodnar"). Applicant respectfully traverses this rejection.

As argued above, the Eggleston, Joseph, Schwartz combination does not teach or suggest the present claims. Bodnar does not cure the combination's deficiencies. Accordingly, Applicant requests withdrawal of this rejection.

Claims 15-21 stand rejected "under the same rationale" as claims 1-7. Applicant respectfully traverses this rejection based on the arguments made for claims 1-7. Accordingly, Applicant requests withdrawal of this rejection.

### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

Dated: January 27, 2009

By:       /Shawn Diedtrich/        
Shawn Diedtrich  
Registration No. 58,176  
480.704.4615 (direct)

Berry & Associates P.C.  
9255 Sunset Boulevard, Suite 810  
Los Angeles, CA 90069  
(310) 247-2860